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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,224	11/12/2003	Kim B. Brignull	2294.002	6311
23405	7590	09/22/2005	EXAMINER	
HESLIN ROTHENBERG FARLEY & MESITI PC			WILLIAMS, JAMILA O	
5 COLUMBIA CIRCLE			ART UNIT	
ALBANY, NY 12203			PAPER NUMBER	
			3722	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/706,224	Applicant(s) BRIGNULL, KIM B.	
	Examiner Jamila O. Williams	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amend. filed 6/27/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 39-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over '776 to Feinberg. Feinberg discloses the claimed invention comprising a wallet sized substrate (10) for containing indicia (column 5 lines 34-48 of the specification and figures 1a-c) and a printing area for the indicia (in the case of Feinberg, the card has various areas 16,17,18 for example that receives printing via the computer), as recited in claim 39; a sticker (column 6 lines 20-29) attachable to a building corresponding to the location of the animal (the sticker is inherently capable of attaching to a building, especially since Feinberg discloses that the sticker may be affixed to items other than card 10, column 6 lines 24-25), the sticker including at least one emergency warning indicia, wherein the indicia on the card corresponds to that of the sticker, as recited in claim 51. Feinberg even discloses some of the specific indicia claimed by applicant including: emergency warning indicia, address, contact person (figs 1a-c), as recited in claim 39.

Feinberg does not however, disclose the specific arrangement and/or contents of the indicia (printed matter) set forth in the all of the claims. For example: indicia for identifying a contact person, as recited in claim 41; indicia for identifying the address for locating the animal in need of care and the contact person, as recited in claim 42; veterinarian information, as recited in claims 45; the specific types of warning indicia, recited in claims 47-48, the specific indicia on the sticker, recited in claim 51. It would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the indicia on the substrate since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate (card 10) may render the device more convenient by providing an individual with a specific type of information or instruction does not alter the functional relationship. Mere support for the printed matter is not the kind of functional relationship necessary for patentability. Thus there is no novel and unobvious functional relationship between the printed matter (e.g. indicia) and the substrate (e.g. card 10), which is required for patentability.

3. Claims 58-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over '776 to Feinberg in view of '046 to Stephens. Feinberg discloses all of the elements of the claims including a substrate for containing emergency indicia and a sticker associated with the card (figs 1a-c and column 6 lines 20-29). Feinberg

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does not however disclose the substrate (card) including a first and second substrate with a score line defining the second substrate into foldable and overlapping first and second portions. Stephens discloses a substrate including a first substrate and a second substrate with a score line there between (fig 1). It would have been obvious to one having ordinary skill in the art to use the substrate of Stephens with the invention of Feinberg for the purpose of covering or protecting personal information from view by folding the first and second substrate upon itself (column 2 lines 9-11 of Stephens). Regarding the specific arrangement and/or content of the indicia recited in the claims, see the rejection to Feinberg as applied to claim 39 above.

Regarding the color of the indicia as recited in claims 49,68, it would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the color of the indicia (i.e. red) as a matter of design choice.

Response to Arguments

Applicant's arguments filed 6-27-2005 have been fully considered but they are not persuasive. The applicants arguments with regards to the Feinberg and Stephens references failing to teach or suggest a card as claimed by applicant, are not persuasive. The examiner maintains that the claimed indicia is not functionally related to the substrate (card). It has been held that when the claimed printed matter (or indicia) is not functionally related to the substrate, it will not distinguish over the prior art. *In re Gulack*, 217 USPQ 401.

The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the card of Feinberg comprising indicia and a removable sticker thereon is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. indicia) and the substrate (e.g. card), which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamila O. Williams whose telephone number is 571-272-4431. The examiner can normally be reached on Mon-Fri 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JW 9/19/2005



BOYER D. ASHLEY
PRIMARY EXAMINER